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09/618,615	07/18/2000	Gary W. Sinde	6573-62441	9299
23643 7590 08/12/2009 BARNES & THORNBURG LLP 11 SOUTH MERIDIAN INDIANAPOLIS, IN 46204				
EXAMINER CHAMPAGNE, DONALD				
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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* GARY W. SINDE
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11 Appeal 2009-00551
12 Application 09/618,615
13 Technology Center 3600
14

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16 Decided: August 10, 2009
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19 *Before* MURRIEL E. CRAWFORD, ANTON W. FETTING, and BIBHU R.
20 MOHANTY, *Administrative Patent Judges*.

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22 CRAWFORD, *Administrative Patent Judge*.
23

24
25 DECISION ON APPEAL

STATEMENT OF THE CASE

Gary W. Sinde (Appellant) seeks our review under 35 U.S.C. § 134 (2002) from a final rejection of claims 1-40. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellant invented systems and methods for identifying sources of ingress noise into networks (Specification, p. 1, ll. 9-11).

Claim 1 under appeal is further illustrative of the claimed invention as follows:

1. A method of identifying a source of ingress into a network including storing frequency spectra of known sources of ingress, comparing the frequency spectrum of ingress to the frequency spectra of known sources of ingress, and determining from the comparison which of the frequency spectra of known sources of ingress is closest to the frequency spectrum of the ingress.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Nickolls et al.	US 5,251,626	Oct. 12, 1993
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Eberhart et al.	US 6,516,309 B1	Feb. 4, 2003
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Declaration of Donald L. Champagne, P.E., Ph.D., mailed with an Office action on 9 November 2007 (hereinafter “Champagne Declaration”).

The Examiner rejected claims 1-4, 6-9, 11-14, 16-19, 21-24, 26-29, 31-34, and 36-39 under 35 U.S.C. § 103(a) as being unpatentable over Nickolls; and rejected claims 5, 10, 15, 20, 25, 30, 35, and 40 under 35 U.S.C. § 103(a) as being unpatentable over Nickolls in view of Eberhart.

We REVERSE.

ISSUE

Did the Appellant show the Examiner erred in finding that the Champagne Declaration provides an adequate factual basis for showing that identifying an abnormality that is “an ingress” into a network was known at the time of the claimed invention?

FINDINGS OF FACT

Specification

01.Appellant invented systems and methods for identifying sources of ingress noise into networks (Specification, p. 1, ll. 9-11).

Nickolls

02.Nickolls discloses medical devices which: monitor the cardiac state of a patient by sensing the patient’s intrinsic rhythm for the presence of arrhythmias, diagnose the condition, and deliver therapy to restore a normal sinus rhythm to the patient (col. 1, ll. 11-23).

03.A neural network is used to recognize ventricular fibrillation (VF) and other forms of arrhythmias in real time (col. 1, ll. 24-29).

04.The physiological signals detected by the device may include raw electrocardiogram (ECG) signals, blood impedance measurement waveforms, ventricular filtered peak-to-peak pressure amplitude (VFPPA) or ventricular peak pressure function (VPPF) signals, arterial pressure of oxygen (pO₂), partial pressure of carbon dioxide (pCO₂), potential of hydrogen (pH), blood temperature, ventricular wall impedance, ventricular volume, and blood flow signals, or other

1 similar signals known to those skilled in the art (col. 6, ll. 5-13).
2 05. Arrhythmia includes tachyarrhythmias, fibrillation, tachycardias,
3 supraventricular tachycardias (SVT), ventricular tachycardias (VT),
4 ventricular flutter and VF, and bradycardia (col. 7, ll. 3-8).
5 06. Sensing circuit 37 detects analog signals 40 from heart 14 (col. 9, ll.
6 47-49).
7

8 PRINCIPLES OF LAW

9 *Prior Art*

10 A person shall be entitled to a patent unless - (a) the invention was
11 known or used by others in this country, or patented or described in a printed
12 publication in this or a foreign country, before the invention thereof by the
13 applicant for a patent. 35 U.S.C. § 102(a)

14 The statutory language “known or used by others in this country” (35
15 U.S.C. § 102(a)), means knowledge or use which is accessible to the public.”
16 *Carella v. Starlight Archery*, 804 F.2d 135, 139 (Fed. Cir. 1986).

17 Argument in the brief does not take the place of evidence in the
18 record. *In re Schulze*, 346 F.2d 600, 602 (CCPA 1965).
19

20 *Obviousness*

21 During examination, the examiner bears the initial burden of
22 establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d
23 1443, 1445 (Fed. Cir. 1992).

24 When a work is available in one field [of endeavor], design
25 incentives and other market forces can prompt variations of it,

either in the same field or [a different one]. If a person of ordinary skill can implement a predictable variation, and would see the benefit of doing so § 103 likely bars its patentability. Moreover, for the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 417 (2007).

The analysis of the apparent reasons to combine the known elements in the fashion claimed by the patent at issue should be made explicit. *KSR*, 550 U.S. at 418 (2007).

The analogous arts test begins the inquiry into whether a skilled artisan would have been motivated to combine references by defining the prior art relevant for the obviousness determination, and that it is meant to defend against hindsight. The motivation-suggestion-teaching test picks up where the analogous art test leaves off and informs the Graham analysis. *In re Kahn*, 441 F.3d 977, 986 (Fed. Cir. 2006).

ANALYSIS

We are persuaded of error on the part of the Examiner by Appellant's argument that the Champagne Declaration does not provide an adequate factual basis for showing that identifying an abnormality that is an ingress into a network was known at the time of the claimed invention (App. Br. 22-24; Reply Br. 5-6). The crux of whether something was known or used by

1 others in this country is whether the “knowledge or use was accessible to the
2 public.” *See Carella*, 804 F.2d at 139. The Champagne Declaration fails in
3 this regard. Aside from the assertion that, “[c]ombustion noise was known
4 to have caused fatigue failures in rockets and aircraft gas turbine engines.”
5 (Champagne Declaration 4), there is no indication that any of the other
6 knowledge or uses set forth in the Champagne Declaration was publicly
7 known or accessible at the time of the invention. Specifically, while the
8 Champagne Declaration sets forth what the *declarant* knew and performed
9 from 1973 to 1976, the Champagne Declaration does not set forth any facts
10 to indicate that what the declarant knew and performed was *publicly* known
11 and accessible.

12 The Examiner does attempt to remedy this deficiency by asserting on
13 pages 10-11 of the Examiner’s Answer that “[t]he declaration did fail to
14 expressly note, as the examiner has now done above, that the GE task force
15 used off-the-shelf diagnostic equipment and otherwise relied on publicly-
16 known art. Nothing attested to here or in the declaration was a GE trade
17 secret.” However, such an attempted remedy is insufficient because these
18 statements must be set forth within the four corners of the declaration in
19 order to be given evidentiary weight. *See In re Schulze*, 346 F.2d at 602.

20 Accordingly, because (1) the Examiner bears the initial burden of
21 establishing a prima facie case of obviousness under *In re Oetiker*, 977 F.2d
22 at 1445, (2) the Examiner admits on page 4 of the Examiner’s Answer that
23 Nickolls does not teach that the abnormality is an ingress into (external to) a
24 network, and (3) the Champagne Declaration does not provide an adequate
25 factual basis for showing that identifying an abnormality that is an ingress

1 into a network was known at the time of the claimed invention, the
2 Examiner has failed to establish a proper prima facie case of obviousness
3 with respect to the rejections of claims 1-40.

4 Moreover, we also agree with the Appellant that the Examiner has
5 failed to provide an explicit reasoning as to why one of ordinary skill would
6 modify Nickolls to identify an abnormality that is an ingress into (external
7 to) a network (App. Br. 25). The Examiner is correct that *KSR* recites that
8 predictable variations likely bar patentability. *See KSR*, 550 U.S. at 417.
9 However, the key word is “likely,” because even if the variation is
10 predictable, the Examiner must still set forth an explicit reason to combine
11 the known elements in the fashion claimed by the patent at issue. *See Id.* at
12 418.

13 Although primarily set forth in the non-analogous art context, the
14 Appellant has essentially argued that there would be no reason to modify
15 Nickolls to identify abnormalities external to the heart, because Nickolls is
16 directed to identifying, diagnosing, and treating abnormalities (arrhythmias)
17 internal to the system (heart), (App. Br. 17, 19, 20-21; Reply Br. 2-4)¹.
18 Indeed, all the arrhythmia conditions set forth in Nickolls are internal to the
19 heart. While Nickolls does not preclude identifying abnormalities external
20 to the heart, the Examiner has not provided *any* reason (e.g., design
21 incentives, market forces, improvements, etc.) as to why one of ordinary

¹ We agree with the Examiner that Nickolls is analogous art to the claimed invention because they are both directed to identifying frequency spectra abnormalities. However, just because a reference is analogous art and could be used to in an obviousness rejection does not, by itself, satisfy the separate requirement that the Examiner must provide a reason for combining references. *See In re Kahn*, 441 F.3d at 986.

1 skill would wish to do so. Accordingly, because the fact that a variation is
2 possible, without more, is not a reason for combining known elements, the
3 Examiner has also failed in this regard to establish a proper prima facie case
4 of obviousness with respect to the rejections of claims 1-40.

5
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7 **CONCLUSION OF LAW**

8 On the record before us, Appellant has shown that the Examiner erred
9 in finding that Nickolls and the Champagne Declaration render obvious the
10 subject matter of claims 1-40.

11
12 **DECISION**

13
14 The decision of the Examiner to reject claims 1-4, 6-9, 11-14, 16-19,
15 21-24, 26-29, 31-34, and 36-39 under 35 U.S.C. § 103(a) as being
16 unpatentable over Nickolls; and to reject claims 5, 10, 15, 20, 25, 30, 35, and
17 40 under 35 U.S.C. § 103(a) as being unpatentable over Nickolls in view of
18 Eberhart is reversed.

19 No time period for taking any subsequent action in connection with
20 this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(v).

21
22 **REVERSED**

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24 mev
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